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EXAMINER
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MAYO-PINNOCK, TARA LEIGH

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FRANK FORREST HUMBLER

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Appeal 2009-000647  
Application 10/698,205  
Technology Center 3600

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Decided: January 21, 2010

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*Before:* JENNIFER D. BAHR, STEFAN STAICOVICI, and KEN B.  
BARRETT, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

## STATEMENT OF THE CASE

Frank Forrest Humbles (Appellant) appeals under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 1-12. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

### *The Invention*

Appellant's claimed invention is directed to an apparatus for positioning a patient's arms in proximity to a patient's body. Spec. 1.

Claim 1, reproduced below, is illustrative of the claimed invention.

1. An arm protection apparatus for positioning a patient's arms when in a prone or supine position on a patient support comprising:

(a) at least one soft cushion pad with a central portion positionable under the patient's body;

(b) on said at least one soft cushion pad, a soft cushion pad right arm upper section positionable around an upper right arm of a patient including means for attaching said soft cushion pad right arm upper section to said central portion of said at least one soft cushion pad so that said soft cushion pad right arm upper section is folded around a patient's upper right arm;

(c) on said at least one soft cushion pad, a left soft cushion pad arm upper section positionable around an upper left arm of a patient including means for attaching said left arm soft cushion pad upper section to said central portion of said at least one soft cushion pad so that said soft cushion pad left arm upper section is folded around a patient's upper left arm;

(d) on said at least one soft cushion pad, a right soft cushion pad arm lower section

positionable around a lower right arm of a patient including means for attaching said soft cushion pad right arm lower section to said central portion of said at least one soft cushion pad so that said soft cushion pad right arm lower section is folded around a patient's lower right arm;

(e) on said at least one soft cushion pad, a soft cushion pad left arm lower section positionable around a lower left arm of a patient including means for attaching said soft cushion pad left arm lower section to said central portion of said at least one soft cushion pad so that said soft cushion pad left arm lower section is folded around a patient's lower left arm.

### *The Rejections*

The Examiner relies upon the following as evidence of unpatentability:

Ogburn	US 2,245,293	Jun. 10, 1941
Witter	US 3,884,225	May 20, 1975
Tari	US 4,662,366	May 5, 1987

Appellant seeks review of the Examiner's rejections under 35 U.S.C. § 112, second paragraph, of claims 2-6 and 10-12 as indefinite, and under § 103(a) of claims 1-6 as unpatentable over Ogburn, Witter, and Tari; of claims 7-11 as unpatentable over Ogburn and Witter; and of claim 12 as unpatentable over Ogburn, Witter, and Tari.

### SUMMARY OF DECISION

We AFFIRM.

## ISSUES

The Examiner rejected claims 2-6 as indefinite because the limitation requiring that the soft cushion pad be "easily cut" is a relative term without a suitable standard for ascertaining the requisite degree. Ans. 3. Further, the Examiner rejected claims 3 and 10-12 as indefinite because the limitation requiring that the "means for attaching" is "easily and quickly" attached and detached is likewise a relative term. *Id.* Appellant argues that claim 2, and thus claims 3-6, are not indefinite because the Specification provides a standard for "easily cut" whereby the cushion pad is "easily cut or torn by standard cutting devices, such as scissors." Appeal Br. 20-22. Further, Appellant argues that claims 3-6 and 10-12 are not indefinite because the terms are merely descriptive of the "means for attaching," which are hook-and-eye devices such as Velcro<sup>™</sup>, and because the "means for" language is authorized by 35 U.S.C. § 112, sixth paragraph. Appeal Br. 21-22.

The Examiner rejected claim 1 with a proposed combination of Ogburn, Witter, and Tari. In particular, the Examiner concluded that it would have been obvious to modify the arm restraining device of Ogburn to include the cushion pad of Witter and the upper and lower arm constraints of Tari. Ans. 4-6. The Examiner reasoned that it would have been obvious to modify Ogburn's restraints to include a soft cushion pad as taught by Witter in order to enhance comfort, and to include upper and lower sections on the right and left arm supports as taught by Tari in order to support the upper and lower sections of the patient's arms. Ans. 6. Appellant argues that Ogburn does not describe an "arm protection apparatus" and that the padding in Ogburn is underneath hard leather cuffs and therefore cannot correspond to the "soft cushion pad" limitation. Appeal Br. 10-11.

The Examiner concluded that the subject matter of claims 7 and 8 is obvious in view of a proposed combination of Ogburn's arm restraining device and Witter's cushion. Ans. 7-8. Appellant argues that the Examiner's combination fails to properly address the "arm section cushion pad" limitation because a leather cuff covers Ogburn's arm section cushion pad. Appeal Br. 16-17.

The Examiner concluded that the subject matter of claim 9 is obvious in view of a proposed combination of Ogburn's arm restraining device and Witter's cushion because one of ordinary skill in the art would recognize the need to make the material of the cushion pad radiolucent, to permit radiological operations to be performed on a patient "while positioned in the arm protection apparatus." Ans. 8-9. Appellant argues that Ogburn does not suggest that it would be desirable to use radiolucent materials. Appeal Br. 15, 18.

Therefore, the issues presented in this appeal are:

- (1) Has Appellant demonstrated that the Examiner erred in concluding that claims 2-6 are indefinite because the metes and bounds of the limitation "easily cut" cushion pad would be understood by one of ordinary skill in the art in view of the Specification's description of a device that is "easily cut or torn by standard cutting devices, such as scissors," such that a determination as to the patentability of these claims under 35 U.S.C. § 103 can be made?
- (2) Has Appellant demonstrated that the Examiner erred in concluding that claims 3-6 and 10-12 are indefinite because it would be understood by one of ordinary skill in the art that the "easily and quickly attached and detached" limitation is merely descriptive and

- therefore not limiting to the "means for attaching," such that a determination as to the patentability of these claims under 35 U.S.C. § 103 can be made?
- (3) Has Appellant demonstrated that the Examiner erred in concluding that the subject matter of claim 1 is obvious in view of the combined teachings of Ogburn, Witter, and Tari because Ogburn's cushion pad is covered by a leather cuff and thus cannot be a "soft cushion pad" as recited in claim 1?
- (4) Has Appellant demonstrated that the Examiner erred in concluding that the subject matter of claims 7 and 8 is obvious in view of the combined teachings of Ogburn and Witter because Ogburn's cushion pad is covered by a leather cuff and thus cannot be a "cushion pad" as recited in claims 7 and 8?
- (5) Has Appellant demonstrated that the Examiner erred in concluding that the subject matter of claim 9 is obvious in view of the combined teachings of Ogburn and Witter because Ogburn does not explicitly describe the cushion pad material as radiolucent?

## FACTS PERTINENT TO THE ISSUES

### (FINDINGS-OF-FACT (FF))

- FF1 Ogburn's device is an arm restraint designed to protect both the patient and the surgeon. Pg. 1, left col., ll. 1-20.
- FF2 One of ordinary skill in the art would readily understand that Ogburn's device is capable of protecting an arm by restraining the motion of the arm, in that the arm is prevented from falling off the table and striking another object, person, or part of the patient's body or moving to or

- resting in an awkward or unnatural position that unduly stretches or strains the patient's arm.
- FF3 Ogburn describes that cuffs 16 and 17 are made of a spongy padding 19 enclosed in thin, flexible leather attached to a strip of stiff leather. Pg. 1, right col., l. 54 to pg. 2, left col., l. 6.
- FF4 One of ordinary skill in the art would have readily understood that "radiolucent" means "partly or wholly permeable to radiation." *Webster's Ninth New College Dictionary* (1988). The use of radiolucent materials is well-known to those of ordinary skill in the medical arts. *See, e.g.*, Appellant's Spec. 3, "Tari ... illustrate[s] the desirability of a radiolucent securing device for a patient's arm"; Tari, col. 3, ll. 1-2.

#### PRINCIPLES OF LAW

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*



Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.

*Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). *See also Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment).

Statements of intended use in an apparatus claim do not distinguish the claim over the prior art apparatus. *In re Sinex*, 309 F.2d 488, 492 (CCPA 1962). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner)).

## ANALYSIS

### *Issue (1) - Indefiniteness of Claims 2-6*

When a word of degree is used, such as the term "easily," it is necessary to determine whether the specification provides some standard for measuring that degree. *See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984). Appellant's argument that the Specification provides sufficient guidance as to the metes and bounds of a material of a cushion pad that is "easily cut" is not persuasive. Appellant points to a passage in the Specification that states that the "device should be easily cut ... by standard cutting devices, such as scissors...." Spec. 3. This passage is unavailing. First, the example provided in the Specification does not make specific reference to the particular material of the soft cushion pad, but instead refers to characteristics of the "device," that is, the arm protection apparatus as a whole. Spec. 3. This description supplements the broad category of "standard cutting devices" with a further example of "scissors." However, "standard cutting devices" in a medical context covers a variety of common cutting implements besides scissors that can cut through an assortment of materials. For example, bone saws, scalpels, drills, and lasers provide a range of cutting power that can cut many types of materials. Even assuming the passage alluded to by Appellant were directly speaking to the limitation at issue, it provides no actual guidance as to the metes and bounds of "easily cut." Thus, claim 2 and claims 3-6, which depend from claim 2, are indefinite. *See In re Johnson*, 558 F.2d at 1015 (claims must "set out and circumscribe a particular area with a reasonable degree of precision and particularity").

Furthermore, because the limitation is indefinite, the prior art rejection of claims 2-6 under 35 U.S.C. § 103(a) must fall because it is necessarily based on a speculative assumption as to the meaning of the claims. *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). We reverse the rejection of claims 2-6 under 35 U.S.C. § 103(a) as being unpatentable over Ogburn, Witter and Tari. It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

*Issue (2) - Indefiniteness of Claims 3-6 and 10-12*

Claims 1 and 7, from which claims 3 and 10 depend, respectively, recite a "means for attaching" an arm section to the central section. Claim 3 recites that the means for attaching "readily," "easily," and "quickly" attach and detach. Claim 10 recites that the means for attaching "readily" attach and detach so that the pads may be "quickly" used. Appellant states that under § 112, sixth paragraph, the "means for attaching" is a hook-and-eye attachment tape, such as Velcro<sup>™</sup> and equivalents. Appeal Br. 21. Appellant's argument that claims 3 and 10 are not indefinite because the terms "easily" and "quickly" are merely descriptive of hook-and-eye devices is not persuasive because its reasoning renders the limitations at issue, and indeed both claims 3 and 10, superfluous. *See Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions that render phrases in claims superfluous); *Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) ("claims are interpreted with an eye toward giving effect to all terms in the claim."). If superfluous claim language were

to remain, the claim would not be setting forth the metes and bounds of the claim with reasonable precision and clarity. *See In re Johnson*, 558 F.2d at 1015; *see also In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969)

(Applicant has the opportunity to amend the claims during prosecution, and broad interpretation reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified).

In effect, the broadest reasonable interpretation of claims 3 and 10 is narrower than Appellant suggests. The plain meaning of the claims is to limit the "means for attaching" to those means for attaching that are "easily and quickly attached and detached." However, the claims and Specification leave ambiguities: easier than what; quicker than what; how much easier; how much quicker? Claims 4-6 depend from claim 3 and claims 11 and 12 depend from claim 10. As such, claims 3-6 and 10-12 are insolubly ambiguous. *See In re Johnson*, 558 F.2d at 1015.

The prior art rejections of claims 3-6 and 10-12 must fall because they are necessarily based on a speculative assumption as to the meaning of the claims. *In re Steele*, 305 F.2d at 862-63. As already indicated above, we reverse the rejection of claims 3-6 under 35 U.S.C. § 103(a) as being unpatentable over Ogburn, Witter and Tari. We likewise reverse the rejection of claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Ogburn and Witter and the rejection of claim 12 as being unpatentable over Ogburn, Witter, and Tari. It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

*Issue (3) - Obviousness of Claim 1*

Claim 1 recites an arm protection apparatus comprising four soft cushion pad arm sections corresponding to upper and lower left and right arm sections. Appellant first argues that Ogburn's restraining device is not an arm protection apparatus because Ogburn does not describe it as such. Appeal Br. 10-11.

Claim 1 recites an "arm protection apparatus" in the preamble, and subsequently sets forth certain structural limitations of the apparatus. Thus, any device capable of performing the intended use of the claimed structure, that is, of protecting an arm, would satisfy the claimed intended use. *In re Sinex*, 309 F.2d at 492 (statements of intended use in an apparatus claim do not distinguish the claim over the prior art apparatus); *In re Schreiber*, 128 F.3d at 1477 (a reference device capable of performing as claimed, but not described as performing as claimed, still anticipates the claim). Ogburn's device is an arm restraint designed to protect both a patient and a surgeon. FF1. Appellant has not shown that Ogburn's device is incapable of protecting a patient's arm. At a minimum, Ogburn's device protects a patient's arm by securing it from falling off the bed or striking another object, person, or body part. FF2. Thus, the device in Ogburn is capable of protecting an arm.

Appellant argues that the padding described in Ogburn is underneath hard leather cuffs and therefore not a soft cushion pad as claimed. Appeal Br. 10-11. However, claim 1 merely requires that the structure of the arm protection apparatus *comprise* soft cushion pads, not that the apparatus *consist* of soft cushion pads. Ogburn clearly describes soft cushion pads. FF3. There is no requirement in the claim that another material cannot back

the soft cushion pads. Therefore, Appellant's argument that Ogburn's cuffs have leather on top of the soft cushion pads is not commensurate with the scope of claim 1.

*Issue (4) - Obviousness of Claims 7 and 8*

Appellant argues that the Examiner's rejections of claims 7 and 8 are in error because Ogburn's cushion pads are covered in leather. Appeal Br. 16-17. However, for the same reasons set forth in our discussion of Issue (3) above, Appellant's argument is not commensurate with the scope of claims 7 and 8.

*Issue (5) - Obviousness of Claim 9*

Claim 9 requires that the soft cushion pads are radiolucent. Appellant argues that Ogburn does not discuss any desire for the cuffs to be radiolucent. Appeal Br. 15, 18. However, the Examiner does not rely on Ogburn to teach a radiolucent cushion. Instead, the Examiner concluded that it would have been obvious to have radiolucent cushion pads in the proposed combination of Ogburn and Witter. Ans. 8. Appellant does not allege that radiolucent materials are not well known. Indeed, the evidence before us indicates that the use of radiolucent materials is notorious throughout the medical arts. FF4. Without evidence that the incorporation of such a well-known type of material represents an unobvious step over the prior art arm protection devices, it is unclear how the inclusion of the well-known material for its well-known property in devices already known to include such materials is anything more than common sense. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*

*Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416-19 (2007) (holding obvious the inclusion of a known device because there was no evidence presented that the inclusion of the known device in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art"); *In re Leshin*, 277 F.2d 197, 199 (CCPA 1960) (the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art). Thus, Appellant has not demonstrated error in the Examiner's conclusion of obviousness.

### CONCLUSIONS

- (1) Appellant has not demonstrated that the Examiner erred in concluding that claims 2-6 are indefinite. The Specification's example of "easily cut or torn by standard cutting devices, such as scissors" does not render definite the metes and bounds of the limitation "easily cut." Therefore, we sustain the Examiner's § 112, second paragraph, rejection of claims 2-6 and reverse the Examiner's § 103 rejection of claims 2-6 as necessarily based on a speculative assumption as to the meaning of the claims.
- (2) Appellant has not demonstrated that the Examiner erred in concluding that claims 3-6 and 10-12 are indefinite. It would not be understood by one of ordinary skill in the art that the "easily and quickly attached and detached" limitation is merely descriptive and therefore not limiting to the "means for attaching." Therefore, we sustain the Examiner's § 112, second paragraph, rejection of claims 3-6 and 10-12 and reverse the Examiner's § 103 rejections of claims 2-6 and 10-12 as

- necessarily based on a speculative assumption as to the meaning of the claims.
- (3) Appellant has not demonstrated that the Examiner erred in concluding that the subject matter of claim 1 is obvious in view of the combined teachings of Ogburn, Witter, and Tari. A leather cuff covers Ogburn's cushion pad but this does not prevent the pad from corresponding to the "soft cushion pad" limitation. Therefore, we sustain the Examiner's § 103 rejection of claim 1.
- (4) Appellant has not demonstrated that the Examiner erred in concluding that the subject matter of claims 7 and 8 is obvious in view of the combined teachings of Ogburn and Witter. A leather cuff covers Ogburn's cushion pad, but this does not prevent the pad from corresponding to the "cushion pad" limitation. Therefore, we sustain the Examiner's § 103 rejection of claims 7 and 8.
- (5) Appellant has not demonstrated that the Examiner erred in concluding that the subject matter of claim 9 is obvious in view of the combined teachings of Ogburn and Witter. Therefore, we sustain the Examiner's § 103 rejection of claim 9.

#### DECISION

The Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED



Appeal 2009-000647  
Application 10/698,205

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